

REMARKS

Pursuant to 37 C.F.R. §1.111, reconsideration of the instant application, as amended herewith, is respectfully requested. Entry of the amendment is requested.

Claims 1-16 are presently pending before the Office. No claims have been canceled. Applicant has amended claim 9. No new matter has been added. Support for the amendments can be found throughout the specification as originally filed. Applicant is not intending in any manner to narrow the scope of the originally filed claims.

The Examiner's Action mailed December 14, 2005 and the references cited therein have been carefully studied by Applicant and the undersigned counsel. The amendments appearing herein and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is believed to be in condition for allowance.

The Examiner has objected to the oath/Declaration because it did not indicate a priority claim. The undersigned telephoned the examiner shortly after receipt of the office action and after discussing the format of the declaration, the examiner, agreed to withdraw the objection. The declaration on page 2 clearly states:

“CLAIM FOR BENEFIT OF EARLIER US/PCT APPLICATIONS
UNDER 35 USC 120
I hereby claim the benefit”

The top of page 3 clearly states the PCT application designating the US and the next section states:

“35 USC 119 PRIORITY CLAIM, IF ANY,
FOR ABOVE LISTED US/PCT APPLICATIONS”

The table then lists the JP2002-197597 priority claim.

This format has been used in several previously filed applications and has been routinely accepted by the Patent Office as it is clear what the intent of the applicant is regarding the priority claim. The issue is not form such as whether a block is checked yes or no, the issue is substantive, that is, has the applicant expressed in some form such as "I claim the benefit..." whether he is claiming priority of a foreign application. Applicant has clearly done so in this case.

In addition, this is a 35 USC 371 application under the PCT. Clearly, Applicant claimed priority of the JP application during the international phase. The US official filing receipt clearly indicates that applicant has claimed the benefit of JP2002-197597. Also, the application published as US2005/0166790 on August 4, 2005 and the data capturers further published the JP application number in item (30) entitled "Foreign Application Priority Data."

Applicant therefore respectfully requests that the examiner withdraw his objection to the declaration as the intent to claim priority of the JP application is absolutely clear substantively.

For the reasons delineated on page 2 of the office action, relying on 35 U.S.C. §112, second paragraph, the Office has rejected the subject matter of claims 9-16 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner has also rejected claims 9 and 10-16 under 35 USC 101 for the reasons also stated on page 2 of the office action. Applicant respectfully traverses the rejection and requests reconsideration.

Applicant submits that claims 9-16 do define the legal metes and bounds of the invention.

It is not the role of the claims to enable one skilled in the art to reproduce the invention but rather to define, for those skilled in the art the legal metes and bounds of the invention. Nevertheless, in order to advance the case to allowance, claim 9 has been amended.

It is respectfully submitted that claims 9-16 fully comply with 35 U.S.C. §112, second paragraph. Withdrawal of the rejection is respectfully requested.

Relying on 35 U.S.C. §102(b), the Examiner has rejected the subject matter of claims 1-16 as being anticipated by EP '148. Applicant respectfully traverses the rejection and requests reconsideration.

Applicant respectfully submits that it is important to note that, historically, the Office and the Federal Circuit has required that for a §102 anticipation, a single reference must teach (i.e., identically describe) each and every element of the rejected claim. The Office has steadfastly and properly maintained that view.

The cited reference fails this test as discussed below.

Both the present invention and EP '148 describe a pyrophospheric acid bath for use in cyanogens-free copper-tin alloy plating.

The present invention is characterized in that the pyrophospheric acid bath contains “an amine derivative, an epihalohydrin and a glycidyl ether compound” as additive (A). On the other hand, EP '148 is characterized in that the pyrophospheric acid bath contains as additives “a reaction product (A) of an amine derivative and an epihalohydrin in a 1:1 mole ratio” and “a cationic surfactant (B)”. That is, EP '148 neither describes or suggests containing a glycidyl ether compound, which is an essential component for the present invention.

Plating bath no. 36 described in Table 2 of the present invention is a plating bath described in Example 1 of JP-2001-295092A, which is a Japanese counterpart of EP ‘148, and the plating bath does not contain a glycidyl ether compound. In comparison between this plating bath (No. 36) and the plating bath of the present invention, as understood by Table 2, the plating bath of the present invention can “perform uniform treatment even in those applications where the state of the current application is incessantly changing between a high current density state and a low current density state.” Further, in comparison between a plating obtained by plating bath no. 36 and a plating obtained by the plating bath of the present invention, as understood in Table 3, the present invention exhibits lower defective product generation rates. EP ‘148 includes no description anticipating such remarkable effects of the present invention.

Therefore, the present invention is not described in EP ‘148 and the reference clearly can not anticipate the present invention as claimed.

Accordingly, Applicant respectfully submits that claims 1-16 have not been anticipated by the EP ‘148 reference under 35 U.S.C. §102(b), and respectfully requests that such rejection be withdrawn.

CONCLUSION

Even though the initial claims in this important patent application were drawn to a new, useful and nonobvious invention, they have now been amended to increase their specificity of language. Applicant respectfully submits that claims 1-16 are patentable over the art of record.

A Notice of Allowance is earnestly solicited.

If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (727) 943-9300 would be appreciated.

Very respectfully,

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